



DPW

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of: **ODAN, Yuji et al.**

Group Art Unit: **2829**

Serial Number: **10/632,821**

Examiner: **HOLLINGTON, Jermele M.**

Filed: **August 4, 2003**

Confirmation No.: **9211**

For: **ELECTRONIC CIRCUIT INSPECTION SENSOR AND INSPECTION SYSTEM USING SAME (As amended)**

Customer No. **38834**

Atty. Docket No. **000624A**

REQUEST FOR RECONSIDERATION UNDER 37 C.F.R. § 1.111

Mail Stop: Amendment

Commissioner for Patents

P.O. Box 1450

Alexandria, VA 22313-1450

January 26, 2005

Sir:

Applicants respond herein to the October 29, 2004 Office Action.

As a initial matter, the undersigned notes that item 15 on page 2 of the Application Transmittal form (filed with the application on August 4, 2003) indicates that priority of the corresponding Japanese application is claimed under 35 U.S.C. § 119. Such is not the case, and the indication thereof was unintended and therefore submitted without deceptive intent. Any inconvenience resulting therefrom is regretted.

The present application claims domestic priority as a divisional application, and the effective filing date resulting from the claim for domestic priority is May 17, 2000.

Claims 1-9 stand rejected under 35 U.S.C. § 103(a) as obvious over Takada (U.S. Patent No. 6,201,398) in view of Fujii et al. (U.S. Patent No. 6,710,607). Applicants respectfully traverse this rejection for two independent reasons.

First, as stated above, applicants' effective filing date is May 17, 2000, and this date precedes the date of Fujii et al. Therefore, Fujii et al. cannot be used to support a rejection. For at least this reason alone, the rejection should be withdrawn.

Second, Takada and the present application are both assigned to OHT Inc. The claims are rejected under 35 U.S.C. § 103(a), but 35 U.S.C. § 103(c) indicates that the Takada cannot preclude patentability of the pending claims if both the invention of Takada and the invention of the present application were assigned (or subject to assignment) to OHT Inc. at the time the present invention was made.¹ Under MPEP § 706.02(l)(2),² applicants clearly and conspicuously provide the following statement concerning common ownership:

STATEMENT CONCERNING COMMON OWNERSHIP

Application 10/632,821 and Patent 6,201,398 were, at the time the invention of Application 10/632,821 was made, owned by OHT Inc.

Therefore, in addition to the reason that the Fujii et al. date is not old enough to support a rejection, the rejection should also be withdrawn because the application's common ownership with Takada, the primary reference.

In view of the remarks above, applicants now submit that the application is in condition for allowance. Accordingly, a Notice of Allowability is hereby requested. If for some reason it is believed that this application is not now in condition for allowance, the Examiner is invited to

¹ The Takada disclosure does not "qualify as prior art" under the provisions of 35 U.S.C. § 102(a)-(d). Regarding paragraph (a), the Takada disclosure was not publicly known before applicant's effective date of May 17, 2000. Regarding paragraph (b), the Takada disclosure was not published more than one year before applicant's effective date. Regarding paragraphs (c) and (d), no evidence of record shows that applicant abandoned the invention or obtained a foreign patent of the invention more than a year before applicant's effective date.

² See page 700-55.

contact applicants' undersigned attorney at the telephone number indicated below to arrange for disposition of this case.

In the event that this paper is not timely filed, applicants petition for an appropriate extension of time. The fees for such an extension, or any other fees which may be due, may be charged to Deposit Account No. 50-2866.

Respectfully submitted,
WESTERMAN, HATTORI, DANIELS & ADRIAN, LLP



Joseph L. Felber
Attorney for Applicants
Reg. No. 48,109

1250 Connecticut Avenue, N.W., Suite 700
Washington, DC 20036
Tel: (202) 822-1100
Fax: (202) 822-1111

JLF/

Q:\2000\000624A\000624A response to 10-29-04 action.doc